

REMARKS

Claims 1, 2, 4-15, 17-25 and 27-29 remain pending in the application.

35 USC 112 First Paragraph Rejection of Claim 29

The Office Action rejected claim 29 as allegedly containing subject matter which was not described in the specification under 35 USC 112.

In particular, the specification allegedly does not disclose a switch that is based on receipt of a trigger signal from a base unit of a cordless telephone. The Applicants respectfully disagree.

The Examiner is directed to, e.g., page 5, lines 9-24 that details a remote handset receives ring signals from a base unit. A user can then press a button on the remote handset to switch from listening to MP3 music to answer an incoming call. ① ②

It is respectfully submitted that claim 29 is in full conformance with 35 USC 112. It is respectfully requested that the rejection be withdrawn.

Claims 1, 2, 4-11, 13-15, 17-21, 23-25, 27 and 28 over Benedetto in view of AAPA

In the Office Action, claims 1, 2, 4-11, 13-15, 17-21, 23-25, 27 and 28 were rejected under 35 U.S.C. § 103(a) as being obvious over Benedetto et al., U.S. Patent No. 4,591,661 ("Benedetto") in view of Applicant's Admitted Prior Art ("AAPA"). The Applicants respectfully traverse the rejection.

Claims 1, 2, 4 and 5 recite, *inter alia*, a remote handset of a matched base unit that can switch between performing as a telephony device and an MPEG audio player.

Benedetto appears to disclose a portable cordless telephone transceiver-radio receiver that includes a headset which is driven by an audio output of the radio receiver (col. 2, lines 10-31). The radio receiver is active until a ring signal is detected by the telephone transceiver (Benedetto, col. 3, line 59-col. 4, line 10). In an alternate embodiment, the radio receiver is turned off by a talk/off switch on the handset (Benedetto, col. 6, lines 19-29).

The Office Action correctly acknowledged that Benedetto fails to disclose an MPEG audio player (Office Action, page 3). The Office Action relies on AAPA at page 4, lines 9-13 of the specification to allegedly make up for the deficiencies in Benedetto to arrive at the claimed invention. The Applicants respectfully disagree.

AAPA, page 4, lines 9-13, discloses a conventional MP3 player that a user is able to go walking, jogging or biking with. AAPA also discloses, page 4, lines 9-13, that a user would be required to carry a separate remote handset of a cordless telephone if a user also desires to receive calls.

Benedetto discloses being able to listen to music with a handset of a cordless telephone. However, the music is produced by a radio receiver within the handset. Incorporating a radio receiver in a cordless telephone handset fails to disclose or suggest incorporating a digital audio player in a remote handset, much less incorporating an MPEG audio player in remote handset, as recited by claims 1, 2, 4 and 5.

An MPEG audio player contains circuitry to convert digital music information to an analog form. A conventional radio is an analog device. Analog devices do not require circuitry to convert music from a digital form to an analog form, as would an MPEG player, as recited by claims 1, 2, 4 and 5.

AAPA specifically discloses that conventionally, at the time of the invention, MP3 music players are a distinct device from a remote handset of a cordless telephone. AAPA fails to disclose or suggest incorporating an MPEG audio player function in a remote handset, much less a remote handset of a matched base unit that can switch between performing as a telephony device and an MPEG audio player, as recited by claims 1, 2, 4 and 5.

Neither Benedetto nor AAPA, either alone or in combination disclose, teach or suggest a remote handset of a matched base unit that can switch between performing as a telephony device and an MPEG audio player, as recited by claims 1, 2, 4 and 5.

Claims 6-11, 13-15 and 17 recite, *inter alia*, playing MP3 music from a remote handset of a cordless telephone connected to a PSTN. Claims

18-21, 23-25, 27 and 28 recite, *inter alia*, playing pre-loaded MP3 music from a remote handset of a cordless telephone connected to a PSTN.

As discussed above, Benedetto discloses being able to listen to music with a handset of a cordless telephone. However, the music is produced by a radio receiver within the handset. A radio receiver converts an analog signal transmitted to the radio into an audible signal. Benedetto fails to disclose or suggest playing digital music on a remote handset, much less playing MP3 music and pre-loaded MP3 music from a remote handset of a cordless telephone, as recited by claims 6-11, 13-15, 17-21, 23-25, 27 and 28.

The Office Action correctly acknowledged that Benedetto fails to disclose an MPEG audio player and playing pre-loaded MP3 music (Office Action, page 4). The Office Action relies on AAPA at page 4, lines 9-13 of the specification to allegedly make up for the deficiencies in Benedetto to arrive at the claimed invention. The Applicants respectfully disagree.

As discussed above, AAPA specifically discloses that conventionally, at the time of the invention, an MP3 music player is a distinct device from a remote handset of a cordless telephone. AAPA fails to disclose or suggest playing MP3 music and pre-loaded MP3 music from a remote handset of a cordless telephone, as recited by claims 6-11, 13-15, 17-21, 23-25, 27 and 28.

Neither Benedetto nor AAPA, either alone or in combination, disclose teach or suggest playing MP3 music and pre-loaded MP3 music from a remote handset of a cordless telephone, as recited by claims 6-11, 13-15, 17-21, 23-25, 27 and 28.

Accordingly, for at least all the above reasons, claims 1, 2, 4-11, 13-15, 17-21, 23-25, 27 and 28 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 12 and 22 over Benedetto in view of AAPA and Bartlett

In the Office Action, claims 12 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Benedetto in view of AAPA, and further in view of Bartlett, U.S. Patent No. 5,519,762 ("Bartlett"). The Applicants respectfully traverse the rejection.

The Applicants respectfully suggest that the need to combine as many as three (3) separate patents to allegedly arrive at the presently recited invention is evidence of the non-obviousness of the present invention.

Claims 12 and 22 are dependent on claims 6 and 18 respectively, and are allowable for at least the same reasons as claims 6 and 18.

Claims 12 and 22 recite, *inter alia*, playing MP3 music from a remote handset of a cordless telephone.

As discussed above, neither Benedetto and AAPA, either alone or in combination, disclose, teach or suggest playing MP3 music from a remote handset of a cordless telephone, as recited by claims 12 and 22.

The Office Action relies on Bartlett to allegedly make up for the deficiencies in Benedetto and AAPA to arrive at the recited invention. The Applicants respectfully disagree.

Bartlett appears to disclose a cordless telephone that provides for improved conservation of battery power in a handset unit (Abstract).

Bartlett fails to mention MP3 music, much less playing MP3 music from a remote handset of a cordless telephone, as recited by claims 12 and 22.

Neither Benedetto, AAPA nor Bartlett, either alone or in combination, disclose, teach or suggest playing MP3 music from a remote handset of a cordless telephone, as recited by claims 12 and 22.

Accordingly, for at least all the above reasons, claims 12 and 22 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 1, 2, 4-11, 13-15, 17-21, 23-25, 27 and 28 over Benedetto in view of AAPA

In the Office Action, claims 1, 2, 4-11, 13-15, 17-21, 23-25, 27 and 28 were rejected under 35 U.S.C. § 103(a) as being obvious over Villa-Real, U.S. Patent No. 4,481,382 ("Villa-Real") in view of Applicant's Admitted Prior Art ("AAPA"). The Applicants respectfully traverse the rejection.

Claims 1, 2, 4 and 5 recite, *inter alia*, a remote handset of a matched base unit that can switch between performing as a telephony device and an MPEG audio player.

Villa-Real appears to disclose a cordless musical extension telephone unit (Abstract). A user is able to press a “RED” key to connect a caller with a radio (Villa-Real, col. 5, lines 19-20). In this manner, a tuned in selected AM or FM radio program is conveyed to the other party of a targeted phone (Villa-Real, col. 5, lines 14-16).

The Office Action correctly acknowledged that Villa-Real fails to disclose an MPEG audio player (Office Action, page 8). The Office Action relies on AAPA at page 4, lines 9-13 of the specification to allegedly make up for the deficiencies in Benedetto to arrive at the claimed invention. The Applicants respectfully disagree.

AAPA, page 4, lines 9-13, discloses a conventional MP3 player that a user is able to go walking, jogging or biking with. AAPA also discloses, page 4, lines 9-13, that a user would be required to carry a separate remote handset of a cordless telephone if a user also desires to receive calls.

Villa-Real discloses being able to convey music to a calling party. However, the music is produced by a radio receiver within the handset. Incorporating a radio receiver in a cordless telephone handset fails to disclose or suggest incorporating a digital audio player in a remote handset, much less incorporating an MPEG audio player in a remote handset, as recited by claims 1, 2, 4 and 5.

An MPEG audio player contains circuitry to convert digital music information to an analog form. A conventional radio is an analog device. Analog devices do not require circuitry to convert music from a digital form to an analog form, as would an MPEG player, as recited by claims 1, 2, 4 and 5.

AAPA specifically discloses that conventionally, at the time of the invention, MP3 music players are a distinct device from a remote handset of a cordless telephone. AAPA fails to disclose or suggest incorporating an MPEG audio player function in a remote handset, much less a remote handset of a

matched base unit that can switch between performing as a telephony device and an MPEG audio player, as recited by claims 1, 2, 4 and 5.

Neither Villa-Real nor AAPA, either alone or in combination disclose, teach or suggest a remote handset of a matched base unit that can switch between performing as a telephony device and an MPEG audio player, as recited by claims 1, 2, 4 and 5.

Claims 6-11, 13-15 and 17 recite, *inter alia*, playing MP3 music from a remote handset of a cordless telephone connected to a PSTN. Claims 18-21, 23-25, 27 and 28 recite, *inter alia*, playing pre-loaded MP3 music from a remote handset of a cordless telephone connected to a PSTN.

As discussed above, Villa-Real discloses being able to convey music to a calling party. However, the music is produced by a radio receiver within the handset. A radio receiver converts an analog signal transmitted to the radio into an audible signal. Villa-Real fails to disclose or suggest playing digital music on a remote handset, much less playing MP3 music and pre-loaded MP3 music from a remote handset of a cordless telephone, as recited by claims 6-11, 13-15, 17-21, 23-25, 27 and 28.

The Office Action correctly acknowledged that Villa-Real fails to disclose an MPEG audio player and playing pre-loaded MP3 music (Office Action, page 9). The Office Action relies on AAPA at page 4, lines 9-13 of the specification to allegedly make up for the deficiencies in Benedetto to arrive at the claimed invention. The Applicants respectfully disagree.

As discussed above, AAPA specifically discloses that conventionally, at the time of the invention, an MP3 music player is a distinct device from a remote handset of a cordless telephone. AAPA fails to disclose or suggest playing MP3 music and pre-loaded MP3 music from a remote handset of a cordless telephone, as recited by claims 6-11, 13-15, 17-21, 23-25, 27 and 28.

Neither Villa-Real nor AAPA, either alone or in combination, disclose teach or suggest playing MP3 music and pre-loaded MP3 music from a remote handset of a cordless telephone, as recited by claims 6-11, 13-15, 17-21, 23-25, 27 and 28.

Accordingly, for at least all the above reasons, claims 1, 2, 4-11, 13-15, 17-21, 23-25, 27 and 28 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'William H. Bollman', written over a horizontal line.

William H. Bollman
Reg. No. 36,457

Manelli Denison & Selter PLLC
2000 M Street, NW
Suite 700
Washington, DC 20036-3307
TEL. (202) 261-1020
FAX. (202) 887-0336

WHB/df